

Group III: Claim 32, drawn to a primer able to amplify the nucleic acid encoding said hybrid protein; and

Group IV: Claims 36-44, drawn to methods for screening for an agonist or antagonist of said membrane protein.

In addition, the Examiner is also requiring an election of a single disclosed Species for *each* of the following sub-species type:

- a) additional domains, e.g. spacer or tag;
- b) membrane protein, e.g. M2 muscarinic receptor, olfactory receptor, CFTR, etc.; and
- c) ion channel, e.g. Kir6.2, mscL, etc.

Applicants provisionally elect Group I, Claims 1-29, 34, 35, 45 and 46, with traverse, for further examination. Applicants also elect, with traverse, the following Species: sub-species type (a) – spacer, sub-species type (b) – MRP1, and sub-species type (c) – Kir6.2. Claims 1-3, 5-13, 15, 19-25, and 30-46 read on the elected Species.

Applicants note that the claims of Groups II-IV depend from claims of Group I; as such, these groups are not separable.

In regard to Groups I and IV, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the hybrid product can be used in a materially different process such as the determination of the crystal structure of the protein. However, the Office has not provided reasons and/or examples to support this conclusion. Further, the Office has failed to show that the proposed process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

The Office has characterized the inventions of Groups II- IV as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “the different products of Groups II and III are not necessarily used in or made by the method of Group IV.” However, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Moreover, the MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office, particularly in view of the fact that Groups II and III are classified into the same subclass (class 536, subclass 23.1).

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants’ election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Finally, Applicants remind the Examiner of MPEP §821.04

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Upon a finding of allowability of the elected product claims, Applicants respectfully request rejoinder of withdrawn process claims.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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